

### **REMARKS**

Reconsideration of the Application in view of the above amendments and following remarks is respectfully requested.

#### **I      Status of the Claims**

Claims 1, 5-7, 9, 11, 12, 16, 37 and 38 were previously pending.

Claims 2-4, 10, 13-15 and 17-36 were previously cancelled.

Claims 1, 5-7, 9, 11, 12, 16, 37 and 38 stand rejected.

Claims 1, 9 and 16 have now been amended.

New claims 39-41 have now been added.

No new matter is added.

Claims 1, 5-7, 9, 11, 12, 16 and 37-41 will be pending upon entry of the present amendment.

#### **II     Rejection under 35 U.S.C. § 112**

Claims 1, 5-7, 11, 12, 16, 37 and 38 stand rejected under 35 U.S.C. § 112, second paragraph. It is respectfully submitted that claim 1 has been amended to clarify that the recited stationary seal face members are the “axially floating stationary seal face members.” Support for this amendment may be found, for example at page 25, lines 4-12. The scope of the claim has not changed.

Reconsideration and withdrawal of the rejection of claim 1 and its dependent claims 5-7, 11, 12, 16, 37 and 38 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

#### **III    Rejection under 35 U.S.C. 102**

Claims 1, 7, 16 and 37-38 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,064,205 to Whitford.

Amended independent claim 1 recites “stationary seal face members arranged on axially opposite sides of said rotary seal face member and each having a seal face providing sliding contact with a respective seal face of the rotary seal face member.” Support for this amendment may be found, for example, at page 25, lines 4-12 of the Specification. It is respectfully submitted that Whitford does not describe this feature. In contrast, Whitford describes a sealing arrangement that

is non-contacting. See Whitford, column 3, lines 41-51. Thus, Whitford does not disclose stationary seal face members with a seal face providing sliding contact with a respective seal face of a rotary seal face member, as recited in claim 1. Because Whitford lacks this feature, it cannot anticipate claim 1 or its dependent claims 7, 16 and 37-38.

Moreover, it is respectfully submitted that one of ordinary skill in the art would not “provide contact between the rotor 2 and the stators 3 and 4” “if one wants minimum leakage” as suggested in the Office Action. See Page 6, lines 1-2. In contrast, Whitford teaches away from seals with contacting parts, teaching that “contact between parts leads to relatively high wear rates.” Thus one of ordinary skill in the art would not have been motivated to provide contact between the rotor and stators of Whitford, as suggested by the Examiner.

Furthermore, independent claim 1 recites “one or more magnets each of which is positioned so as to attract both said axially floating stationary seal face members and so as to urge said axially floating stationary seal face members towards said rotary seal face member.” Support for this amendment may be found, for example at page 25, lines 4-12. It is respectfully submitted that Whitford does not disclose a magnet that is positioned so as to attract both axially floating stationary seal face members, as recited in claim 1. Because Whitford does not disclose this additional feature, it cannot anticipate claim 1 or its dependent claims 7, 16 and 37-38 for this additional reason.

Reconsideration and withdrawal of the rejection of claims 1, 7, 16, 37 and 38 is respectfully requested.

### Rejection Under 35 U.S.C. § 103

Claims 1, 5-7, 9, 11-12, 16 and 37-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,109,617 to Laney and U.S. Patent No. 6,805,358 to Dawson et al. (“Dawson”).

Amended independent claim 1 recites “one or more magnets each of which is positioned so as to attract both said axially floating stationary seal face members and so as to urge said axially floating stationary seal face members towards said rotary seal face member.” It is respectfully submitted that a combination of Laney and Dawson does not teach or suggest this feature. The

Examiner contends that it would have been obvious to replace the biasing means of Laney with that of Dawson. See Office Action, page 5, lines 2-7. However, it is respectfully submitted that such a combination would not include each of one or more magnets being positioned so as to attract both axially floating stationary seal face members, as recited in claim 1. It appears that, were the springs of Laney replaced by the magnets 61 of Dawson, each of those magnets could only attract one of seal faces toward the rotary seal ring. Thus, a combination of Laney and Dawson would not teach or suggest a magnet “which is positioned so as to attract both said axially floating stationary seal face members” as recited in claim 1. Therefore, any combination of Laney and Dawson, to the extent proper, could not render obvious claim 1 or its dependent claims 5-7, 911-12, 16 and 37-38.

Reconsideration and withdrawal of the rejection of claims 1, 5-7, 9, 11, 12, 16, 37 and 38 under 35 U.S.C. § 103 is respectfully requested.

#### **New Claims**

New claims 39-41 have now been added. Support for these claims may be found, for example in the Specification at page 25, lines 4-12 and Figs. 3 and 29. Similar to independent claim 1, independent claim 39 recites “at least one magnet rotationally fixed relative to the axially floating stationary seal face members and positioned so as to attract both axially floating stationary seal face members toward the rotary seal face member.” It is respectfully submitted that the cited references, either alone or in combination do not teach or suggest at least this feature of new independent claim 1. Thus, independent claim 39 and its dependent claims 40 and 41 are patentable over the cited references.

In view of the above remarks, Applicant believes the pending application is in condition for allowance. If there are any issues remaining that the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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